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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

Tristan BARBEYRON et al. : EXAMINER: PATTERSON, C.L.

SERIAL NO.: 09/988,200 : GROUP ART UNIT: 1652

FILED: November 19, 2001 :

FOR: GLYCOSYL HYDROLASE GENES AND THEIR USE FOR PRODUCING ENZYMES FOR THE BIO-DEGRADATION OF CARRAGEENANS

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Sir:

This is in response to the requirement for restriction that was made under 35 U.S.C. §§121 and 372 on September 11, 2003.

The Office has required restriction in the present application as follows:

Group I, claims 12-15, drawn to a protein of SEQ ID NO:2 or encoded by a nucleic acid of SEQ ID NO:1.

Group II, claims 12-14 and 16,drawn to a protein of SEQ ID NO:4 or encoded by a nucleic acid of SEQ ID NO:3.

Group III, claim 17, drawn to a method of producing kappa-oligocarrageenans comprising genetically modifying a host cell with a nucleic acid of SEQ ID NO:1.

Group IV, claim 17, drawn to a method of producing kappa-oligocarrageenans comprising genetically modifying a host cell with a nucleic acid of SEQ ID NO:3.

Applicants hereby elect to prosecute, with traverse, the invention of Group I, claims

12-15 drawn to (i) a protein of SEQ ID NO:2; (ii) a protein encoded by a nucleic acid of SEQ ID NO:1; and (iii) a protein having a hydrophobic cluster analysis (HCA) score with the iota-carrageenase of *Alteromonas fortis* which is greater than or equal to 65% over the domain extending between amino acids 164 and 311 of the amino acid sequence of *Alteromonas fortis* that is SEQ ID NO: 2.

Applicants' election is made with traverse for the following reasons:

Under U.S. practice, restriction of an application is proper only if the claims of the restricted groups are either independent or patentably distinct, and there is a burden in searching the entire application. 35 U.S.C. §121; MPEP §803.

Applicants respectfully traverse the restriction requirement on the grounds that the Office has not provided adequate reasons and/or examples to support its conclusion of patentable distinctness or shown that a burden exists in searching all the claims.

The Office has characterized the inventions of Groups I and II as distinct because the "proteins of Groups I and II are structurally different and are patentably distinct." Page 2, penultimate paragraph, of the Office Action. Applicants respectfully point out that the criteria for patentable distinctness are stated in MPEP §806.05-§806.05(i). Applicants note that nowhere in the aforementioned sections of the MPEP is structural distinctness stated to be a basis for rejection. Accordingly, a mere structural difference of the claimed proteins is not a valid basis for restriction. The restriction requirement is therefore believed to be improper, and it should be withdrawn.

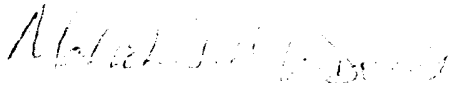
Applicants also respectfully traverse the restriction requirement on the grounds that the Office has not shown even a *prima facie* case that a serious burden would be placed on

the Examiner if the inventions of Groups I-IV were to be examined together. Accordingly, since it has not been shown by the Office that a serious burden would be placed on the Examiner if the inventions of Groups I-IV were to be examined together, Applicants submit that restriction cannot be properly maintained between Groups I-IV. The restriction requirement is clearly improper, and it should be withdrawn.

Finally, Applicants note that MPEP §821.4 states, "where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims directed to a method of using the product should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted



October 3, 2003

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